

### **REMARKS**

Prior to the present amendment, claims 22-30 were pending. The Final Action rejected claims 22-30. Applicant has amended claims 24 and 28 and has added claims 31-41. Allowance of the present application is earnestly solicited in light of the following.

#### **Claim Rejections Under 35 USC 102 (Thomas)**

The Final Action rejected claims 22-23 and 26-27 under 35 USC 102(e) as being anticipated by US Pub. 2004/0072607("Thomas"). Applicant respectfully requests the present rejections of claims 22-23 be withdrawn for the reasons discussed below.

#### **Claims 22-23**

Each of claims 22-23 is directed to a method comprising the steps of initiating a play of a first game in response to determining that a game play button has been actuated, and initiating a play of a second game in response to determining that said game play button has been actuated. Thus, as explained in the Amendment dated July 11, 2008, each of claims 22-23 is directed to a method that initiates the play of two games using a common game play button. In one illustrated embodiment, the common game play button is the start/spin button 22 shown in Figure 3.

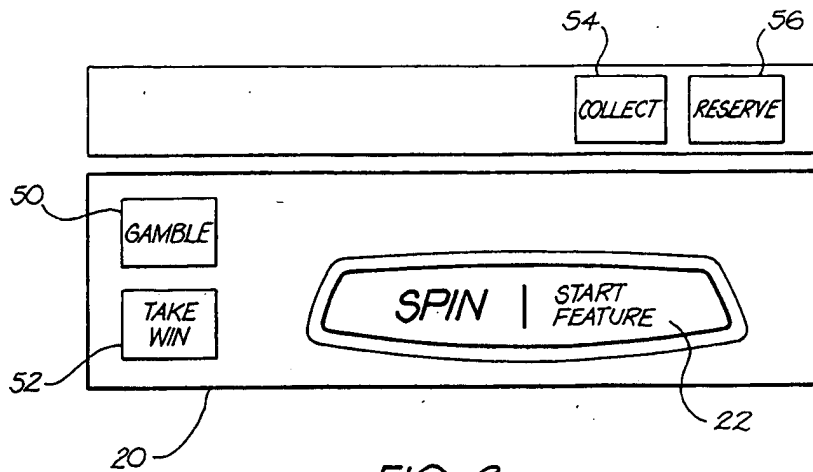


FIG. 3

As shown above in Figure 3, the button 22 in the illustrated embodiment is marked with the word SPIN for the first game, and also marked with the words START FEATURE for the second game (the feature game). That is, a common game play button is used for both games in the illustrated embodiment.

Applicant respectfully submits that Thomas does not teach a method of initiating a play of a first game in response to determining that a game play button has been actuated, and initiating a play of a second game in response to determining that the same game play button has been actuated. The Final Action appears to rely upon Thomas paragraph 27 for a teaching of initiating a play of a first game in response to determining that a button has been actuated and to rely upon Thomas paragraph 50 for a teaching of initiating a play of a second game in response to determining that a button has been actuated.

Applicant respectfully submits that Thomas and paragraphs 27 and 50 in particular do not teach that the same button used to initiate the game of paragraph 27 is the same button used to initiate the game of paragraph 50. In particular, paragraph 27 indicates that "[a]fter activation of the paylines, the reels 14, 16, 18 are set in motion by either pulling a lever 20 or depressing a

push button (not shown) on the slot machine 10." However, paragraph 50 states that "an animated 'hand' pointer scrolls across the grid and window selection is accomplished by the player depressing a designated 'select' button when the hand is pointing to a desired selection." Accordingly, paragraph 27 merely indicates that a push button may be depressed to set the reels 14, 16, 18 in motion but does not otherwise identify which button of the slot machine 10 sets the reels in motion. On the other hand, paragraph 50 states a "select" button may be depressed to make a window selection. Thus, paragraphs 27 and 50 do not explicitly teach that the buttons are the same.

Moreover, Applicant respectfully points out that Thomas does not inherently disclose that the buttons of paragraphs 27 and 50 are the same. As noted at MPEP 2112(IV):

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)

The Final Action has not demonstrated that the button of paragraph 27 and the button of paragraph 50 "must" be the same button. As such, Thomas does not explicitly and/or inherently disclose initiating a play of a first game in response to determining that a game play button has been actuated and initiating a play of a second game in response to determining that said game play button has been actuated. Accordingly, Thomas does not anticipate claims 22-23. Applicant respectfully requests the withdrawal of the present rejection of claims 22-23.

#### Claims 26-27

Each of claims 26-27 is directed to a gaming machine comprising a game play button and an electronic controller to initiate a play of a first game in response to determining that the game play button has been actuated and to initiate a play of a second game in response to determining that the game play button has been actuated. As explained above, Thomas does not explicitly and/or inherently teach a common game play button to initiate a play of a first game and to initiate a play of a second game. Thus, Thomas does not anticipate claims 26-27. Withdrawal of the present rejection of claims 26-27 is earnestly solicited.

#### Claim Rejections Under 35 USC 103 (Thomas/Vancura)

The Final Action rejected claims 24-25 and 28-30 under 35 USC 103(a) as being unpatentable over Thomas in further view of US Pub. 2004/0219963("Vancura"). Applicant has amended claims 24 and 28 to correct minor grammatical errors and not for reasons of patentability. Each of claims 24-25 and 28-30 includes one of claims 22 and 26 as a base claim and is therefore allowable for at least the reasons discussed above in regard to the respective base claim. Withdrawal of the present rejection is earnestly requested.

### **CONCLUSION**

Applicant respectfully submits that all pending claims are in condition for allowance and respectfully requests the allowance of such claims. Applicant hereby further requests that any necessary extension of time fee and any deficiency of fees associated with this communication be charged to Deposit Account 13-0017.

In the event that the Examiner believes a telephone interview with the undersigned Applicant's Representative would be helpful in advancing prosecution of this patent application, the undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,

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